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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,117	11/30/2000	Robert G. Arther	Mo-6049/MD-00-112-TG	2400

7590 12/01/2005

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EXAMINER
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QAZI, SABIHA NAJM

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/727,117

Applicant(s)

ARTHER, ROBERT G.

Examiner

Sabiha Qazi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

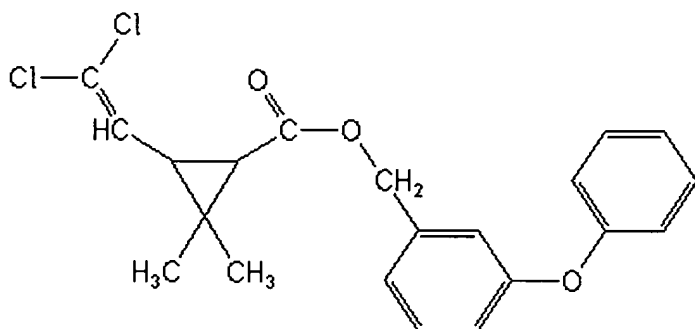
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**Non-Final Office Action**

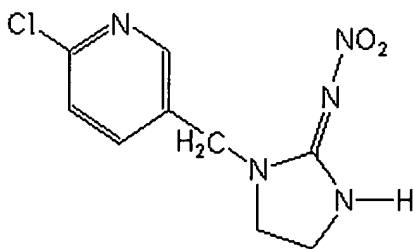
Acknowledgment is made of the response filed on 9/14/05. Claims 9-20 are pending. No claim is allowed.

**The Amendments**

As per restriction requirement made April 12, 2002, Applicant elected without traverse the claims directed to the combination specific pyrethroid and chloronicotinyl: permethrin and imidacloprid, respectively. Claims 9-20 are drawn to non-elected invention.

**Permethrin**

and

**Imidacloprid**

The claims were examined to the extent to the combination of permethrin and imidacloprid. The restriction was made Final. Applicant must amend the claims to the elected invention. Applicant cannot change the elected invention. Process is not the elected invention.

### Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9-20 provisionally rejected under the judicially created doctrine of double patenting over claims 4-7 of copending Application No. 10/682127 (Hereinafter SIRINYAN et al). This is a provisional double patenting rejection since the conflicting claims have not yet been patented. These applications share a common assignee.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: SIRINYAN et al is drawn to skin-friendly dermally applicable liquid

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formulations comprising permethrin and imidacloprid for the method of controlling fleas and/or ticks on "warm-blooded animals." The presently claimed invention is drawn to a process for treating a mammal infected with acarids (fleas or mites) comprising dermally administering to the mammal an effective amount of a composition comprising permethrin and imidacloprid.

It would have been obvious to one skilled in the art at the time of invention because warm-blooded animals, as in SIRINYAN et al, is the same as mammals, as in the presently claimed invention.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### **Claim Rejections - 35 USC § 103---1<sup>st</sup> Rejection**

Claims 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorn et al. (US Patent 6,232,328).

Dorn et al. teach the combination of pyrethroid and nicotinylic compound specifically imidacloprid and permethrin for the control of parasitic insects such as fleas, lice and flies, which embrace presently, claimed invention. See the entire document especially lines 8-10 and lines 35-68 in col. 17; lines 21 and 22 in col. 18; lines 5-10, lines 25-30 in col. 1; lines 5-10 in column 17 and lines 21 and 22 in column 18. Imidacloprid is disclosed in lines 20-25 column 4 and Permethrin is particularly disclosed in lines 21 and 22 in column 18.

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Instant claims differ from the reference in claiming specifically synergistic combination and method of treating wherein prior art teaches that the active compounds can be present in the form of a mixture may be synergists or other active compounds such as pyrethroids etc., see lines 5-10 in col. 17

It would have been obvious to one skilled in the art at the time of invention to prepare additional beneficial composition for controlling insects because prior art teaches control of insects by the same combination of compounds as taught by the prior art. Since the synergistic combination is taught by the prior art therefore there is a motivation to prepare the formulation for controlling insects.

Dorn et al. teaches the combination of pyrethroid and nicotinylic compound for the control of parasitic insects such as fleas, lice and flies. Furthermore, it also teaches that the active compounds can be present in the form of a mixture may be synergists or other active compounds such as pyrethroids etc., see lines 5-10 in col. 17.

The present specification discloses the combination of a pyrethroid and a chloronicotinyl insecticide which provides enhanced activity against ticks and mites, while maintaining the activity of chloronicotinyl compounds against flees”, (lines 20-23 on page 3). Synergistic effect of the combination with chloronicotinyl (imidacloprid) and pyrethroid (permethrin) is disclosed. Since prior art teaches synergistic effect of such combinations, one skilled in the art would expect synergism with any combination such as imidacloprid and permethrin, which has been presently claimed.

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In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

***Claim Rejections - 35 USC § 103---2<sup>nd</sup> Rejection***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorn et al. (US Patent 6,232,328) in combination of Sirinyan et al (US Patents 6,001,858) and Erdelen et al. (US Patent 5,994,331). These references teach the combination, which embraces presently, claimed invention. See the entire documents.

Dorn et al. teach the combination of pyrethroid and nicotinylic compound specifically imidacloprid and permethrin for the control of parasitic insects such as fleas, lice and flies, which embrace presently, claimed invention. See the entire document especially lines 8-10 and lines 35-68 in col. 17; lines 21 and 22 in col. 18; lines 5-10, lines 25-30 in col. 1; lines 5-10 in column 17 and lines 21 and 22 in column 18. Imidacloprid is disclosed in column 4 lines 20-25. Permethrin is particularly disclosed in lines 21 and 22 in column 18.

Sirinyan et al. US '858 teaches the combination of imidacloprid and permethrin for the dermal control of parasitic insects. See the abstract, and lines 35-40 in column 4 for

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imidacloprid and lines 1-2 in column 9 where these compounds are disclosed. See also lines 25-34 in column 8.

Erdelen et al. US '331 teach synergistic combination of chloronicotiny insecticides imidacloprid and various compounds listed in lines 55-68 in column 1 and lines 1-39 in column 2. See claims.

Instant claims differ from the reference in having a broader scope wherein prior art teaches the combination of imidacloprid and permethrin that the active compounds can be present in the form of a mixture may be synergists with other active compounds such as pyrethroids etc., see lines 5-10 in col. 17. Permethrin is particularly disclosed in lines 21 and 22 in column 18.

Since prior art teaches that imidacloprid is synergistic with various pyrethroids and Dorn et al teaches combination of permethrin and imidacloprid may be synergistic one skilled in the art would expect that combination of imidacloprid and permethrin would be synergistic seeing the teaching of prior art.

It would have been obvious to one skilled in the art at the time of invention to prepare additional beneficial composition for controlling insects because prior art teaches control of insects by the same combination of compounds as taught by the prior art. Since the synergistic combination is taught by the prior art therefore there is a motivation to prepare the formulation for controlling insects.

The present specification discloses the combination of a pyrethroid and a chloronicotinyl insecticide which provides enhanced activity against ticks and mites, while maintaining the activity of chloronicotinyl compounds against flees”, (lines 20-23 on page 3). Synergistic effect



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of the combination with chloronicotinylic (imidacloprid) and pyrethroid (permethrin) is disclosed. Since prior art teaches synergistic effect of such combinations, one skilled in the art would expect synergism with any combination such as imidacloprid and permethrin, which has been presently claimed.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SABIHA QAZI, PH.D  
PRIMARY EXAMINER